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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,447	03/20/2002	Hiroyuki Yoshida	107348-00219	7039
4372	7590	06/28/2004	EXAMINER	
ARENT FOX KINTNER PLOTKIN & KAHN 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			NGUYEN, TU MINH	
			ART UNIT	PAPER NUMBER
			3748	

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,447

Applicant(s)

YOSHIDA ET AL.

Examiner

Tu M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,7 and 8 is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. An Applicant's Request for Continued Examination (RCE) filed on June 14, 2004 has been entered. Based on the RCE, an Applicant's Amendment filed on April 13, 2004 has been entered. Claims 3 and 6 have been amended. Overall, claims 1-8 are pending in this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al. (Japan Publication 6-159073).

Re claim 3, as shown in Figure 2, Nakayama et al. disclose an exhaust passage structure in an outboard engine system having a swivel shaft (20) for steering of the outboard engine system in which a catalytic converter (111) for purifying an exhaust gas discharged from an engine (15) is mounted in an exhaust passage for guiding the exhaust gas, the exhaust passage structure comprising:

- at least a portion (114) of the exhaust passage integrally formed in a case member (12a), which is disposed under an engine block (15) to accommodate a drive shaft (20) therein for

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transmitting a driving force from the engine (15) to a propeller (13), the case member being connected to said swivel shaft (20); and

- a connection (108) into which the exhaust passage opens, the connection being formed in a sidewall of the case member (12a);

wherein the catalytic converter (111) is disposed in a space surrounded by the case member (12a) and an exhaust passage-defining member (110a, 110b) so as to be held by the exhaust passage-defining member, the exhaust passage-defining member (110a, 110b) being detachably coupled to the connection (108) of the case member to permit the exhaust gas to flow thereinto.

Re claim 4, in the exhaust passage structure of Nakayama et al., the catalytic converter (111) is supported on the exhaust passage-defining member (110a, 110b).

Re claim 5, in the exhaust passage structure of Nakayama et al., the catalytic converter (111) receives the exhaust gas flow from the case member (12a) via an opening (108) in the exhaust passage-defining member (110a, 110b) communicating with the connection.

Re claim 6, as shown in Figure 2, Nakayama et al. disclose an exhaust passage structure in an outboard engine system having a swivel shaft (20) for steering of the outboard engine system in which a catalytic converter (111) for purifying an exhaust gas discharged from an engine (15) is mounted in an exhaust passage for guiding the exhaust gas, the exhaust passage structure comprising:

- at least a portion (114) of the exhaust passage integrally formed in a case member (12a), which is disposed under an engine block (15) to accommodate a drive shaft (20) therein for transmitting a driving force from the engine (15) to a propeller (13); and

- a connection (108) into which the exhaust passage opens is formed in a sidewall of the case member (12a);

wherein the catalytic converter (111) is disposed in a space surrounded by the case member (12a) and an exhaust passage-defining member (110a, 110b) so as to be held by the exhaust passage-defining member, the exhaust passage-defining member (110a, 110b) being detachably coupled to the connection (108) of the case member; and

wherein the exhaust passage-defining member (110a, 110b) includes an opening (108) to permit the exhaust gas to flow thereinto.

With regard to the preamble directed to a 4-cycle engine, a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie, supra at 480*. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending claim 6 does not rely on the preamble for completeness.

Allowable Subject Matter

4. Claims 1, 2, 7, and 8 are allowed.

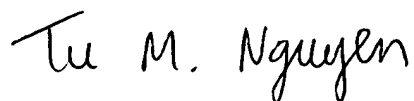
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Communication

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tu Nguyen whose telephone number is (703) 308-2833.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas E. Denion, can be reached on (703) 308-2623. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



TMN

Tu M. Nguyen

June 26, 2004

Patent Examiner

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